



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10.019,680	01.04.2002	James R. Ellsworth	70869-0074US	1027

7590 03.27.2003
Conrad J Clark
Clark & Brody
1750 K Street N W Suite 600
Washington, DC 20006

EXAMINER

SORKIN, DAVID L

ART UNIT	PAPER NUMBER
----------	--------------

1723

DATE MAILED: 03.27.2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,680

Applicant(s)

ELLSWORTH ET AL

Examiner

David L. Sorkin

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4,7 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-10, drawn to a combination tube and a disk.

Group II, claim 11, drawn a disk.

Group III, claims 12-16, drawn to a method decanting.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: While all groups share "a disk", a disk is not a special technical feature because it is known. See for example disk (G) in Hickson (US 280,820 A). Also the disk of Group II is claimed more specifically than the disks mentioned in Groups I and III.

3. During a telephone conversation with Conrad Clark on 20 March 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-16 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what applicant intends by the term "center of buoyancy", whether this is a property of the float itself, such as would be "center of gravity" or if the term relates to combined properties of the float and the fluid components, in which case the term would not be considered limiting in an apparatus claim

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

8. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hickson (US 280,820). Note: the instant claims include several references to fluids intended to be acted upon by the claimed apparatus; however, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thibault*, 164 USPQ 666,667 (Bd. App.

Art Unit: 1723

1969). Regarding claim 1, a tube (A,B) and a disk (G) are disclosed. Regarding claim 2, the disk fits so that there is a gap (see page 1, line 67-69). Regarding claim 3, disk slides on a shaft (D). Regarding claim 4, said disk is arranged to rotate about an axis transverse to the longitudinal axis of said tube (see Fig. 1). Regarding claim 5, a shaft (D) extends along the tube and engages said disk such that said disk slides along said shaft (see page 1, 67-69). Regarding claim 6, said disk includes an upper outer edge and a lower outer edge and the transverse dimension between said upper outer edge and lower outer edge is greater than the internal diameter of said tube (see Fig. 1).

Regarding claims 7 and 8, the upper edge is cylindrical (see Figs. 1 and 2). Regarding claim 9, said disk is shaped such that its center of buoyancy is located above an upper surface of the disk (for example, the upper surface of the lower layer of the float shown in Fig. 1); note also reference character "p"). Note: it is unclear exactly what applicant intends by the term "center of buoyancy", whether this is a property of the float itself, such as would be "center of gravity" or if the term relates to combined properties of the float and the fluid components, in which case the term would not be considered limiting in an apparatus claim.

9. Claims 1, 2 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Park (US 593,333). Note: the instant claims include several references to fluids intended to be acted upon by the claimed apparatus; however, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thibault*, supra. Regarding claim 1, a tube (A) and a disk (D) are disclosed. Regarding claim 2, the disk fits so that

Art Unit: 1723

there is a gap (see page 1, lines 92-93). Regarding claims 7 and 8, the upper surface is cylindrical (see Figs. 1-3). Regarding claim 9, said disk is shaped such that its center of buoyancy is located above an upper surface of the disk (see Figs. 1 and 2). Note: it is unclear exactly what applicant intends by the term "center of buoyancy", whether this is a property of the float itself, such as would be "center of gravity" or if the term relates to combined properties of the float and the fluid components, in which case the term would not be considered limiting in an apparatus claim.

10. Claims 1, 2 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Coleman et al. (US 5,736,033). Note: the instant claims include several references to fluids intended to be acted upon by the claimed apparatus; however, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thibault*, supra. Regarding claim 1, a tube (30) and a disk (10) are disclosed. Regarding claim 2, the disk fits so that there is a gap (see Fig. 1). Regarding claims 7 and 8, the upper surface is cylindrical (see Figs. 1-3). Regarding claim 9, said disk is shaped such that its center of buoyancy is located above an upper surface of the disk (see Figs. 4 and 5). Note: it is unclear exactly what applicant intends by the term "center of buoyancy", whether this is a property of the float itself, such as would be "center of gravity" or if the term relates to combined properties of the float and the fluid components, in which case the term would not be considered limiting in an apparatus claim. Regarding claim 10, the specific gravity of said disk is such that its upper surface will lie just below an interface between plasma and red blood cells (see col. 6, lines 6-9).

Art Unit: 1723

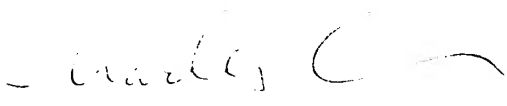
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


David Sorkin

March 20, 2003


CHARLES E. COOLEY
PRIMARY EXAMINER